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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Larry Lawson Jones

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GREENBERG TRAURIG, LLP (SV)

IP DOCKETING

2450 COLORADO AVENUE

SUITE 400E

SANTA MONICA, CA 90404

EXAMINER

ZIA, SYED

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,919

Applicant(s)

JONES ET AL.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-3, 7-14 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-14 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 21, 2006 has been entered.

Response to Amendment

This office action is in response to request for reconsideration filed on August 21, 2006. Original application contained Claims 1-21. Applicant currently amended Claims 1, 9, 11, cancelled Claims 4-5, 15-16, and added new Claims 22-23. Applicant previously amended Claims 1-5, 7, 11-16, 18, and cancelled Claims 6, and 17. The amendment filed have been entered and made of record. Therefore, presently pending claims are 1-3, 7-14, and 18-23.

Response to Arguments

Applicant's arguments filed on August 21, 2006 have been fully considered but they are not persuasive because of the following reasons:

Applicants argued regarding independent Claims 1, and 11 and stated that the cited prior Abbott and Burger fail to teach or suggest, *"a storage medium coupled to the controller, wherein the storage medium is to include security information to be accessed by the controller, and said security information to include at least one of the identity of the individual, an identifier for the device and identifying where the device has been used," either alone or in combination.*" as claimed in currently amended above mentioned independent Claims.

This is not found persuasive. The system of Abbott teaches and describes a key to interface with a wide variety of computers and computer peripherals to supports the user authentication which authenticates the identity of user and memory for storing financial and non-financial media for transaction information. This key provides integrated password and digital certificate management, software security, and personal identification capability in a single compact package. The security information includes a unique identification, embedded into the device, to identify the device (col.3 line 26 to col.4 line 7, col.4 line 50 to line 62, col.5 line 12 to line 15, col.5 line 55 to col.6 line 60, and col.7 line 38 to col.9 line 65). Burger, on the other hand discloses computing environment that describe methods of portable electronic authorization system (Fig.1-2) by engaging transactions involving financial and/or non-financial media and devices, where apparatus has an authenticator that authenticates an identity of a user [Fig.1-2, and paragraph 0019 – 0020] thus providing the authentication of the (personnel) key when tracking the Abbott's device in an external network.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

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suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, because Burger's system of portable electronic authorization with plurality of unique devices provides plurality of services after authenticating the device and user by using embedded ID enhances the trustworthiness of the user of portable device (such as, personnel key) when tracking the device in a external network (co.7 line 9 to line 15).

As a result, the system of cited prior art(s) does implement and teaches a system and method that relates to providing a device for secure identification which also make use of presently available installed infrastructure.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that the system of cited prior arts does teach or suggest the subject matter broadly recited in independent Claims and in subsequent dependent Claims. Accordingly, rejections for claims 1-3, 7-14, and 18-23 are respectfully maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-14, and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. (U. S. Patent 6,671,808), and further in view of Burger (U. S. Pub. 2005/0060586 A1) (hereafter Burger).

1. Regarding Claim 1 Abbott teach and describe a device for allowing secure identification of an individual when accessing information (Fig.2, and 4) comprising: a serial bus port; a controller coupled to the serial bus port; and a storage medium coupled to the controller, wherein, the storage medium is to include security information to be accessed by the controller, and said security information to include at least one of the identity of the individual, an identifier for the device and identifying where the device has been (col.3 line 26 to col.4 line 7, col.4 line 50 to line 62, col.5 line 12 to line 15, col.5 line 55 to col.6 line 60, and col.7 line 38 to col.9 line 65).

Although the system disclosed by Abbot shows all the features of the claimed limitation, as well as secure identification of individuals (users) when using the unique USB enabled device but

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Abbot does not specifically discuss in detail *unique ID embedded inside of the device to identify the device*.

In an analogous art, Burger, on the other hand discloses computing environment that describe methods of portable electronic authorization system (Fig.1-2) by engaging transactions involving financial and/or non-financial media and devices, where apparatus has an authenticator that authenticates an identity of a user [Fig.1-2, and paragraph 0019 – 0020].

Therefore, It would have been obvious to one ordinary skilled in the art at the time of invention to combine the teachings of Abbot and Burger, because Burger's system of portable electronic authorization with plurality of unique devices for providing plurality of services after authenticating the device and user by using embedded ID would enhance the trustworthiness of the user of portable device when tracking the device in a external network (co.7 line 9 to line 15).

2. Regarding Claim 11 Abbott teach and describe a system for allowing for secure identification of an individual when accessing information (Fig.2, and 4) comprising: a central hub; a plurality of key touchpoints coupled to the central hub; and at least one device coupled to at least one of a plurality of key touchpoints, the at least one device comprising a serial port; a controller coupled to the serial port; and a storage medium coupled to the controller, wherein, the storage medium is to include security information to be accessed by the controller, and said security information to include at least one of the identity of the individual, an identifier for the device and identifying where the device has been used (col.3 line 26 to col.4 line 7, col.4 line 50 to line 62, col.5 line 12 to line 15, col.5 line 55 to col.6 line 60, and col.7 line 38 to col.9 line 65).

Although the system disclosed by Abbot shows all the features of the claimed limitation, as well as secure identification of individuals (users) when using the unique USB enabled device but Abbot does not specifically discuss in detail *unique ID embedded inside of the device to identify where the device has been used*.

In an analogous art, Burger, on the other hand discloses computing environment that describe methods of portable electronic authorization system (Fig.1-2) by engaging transactions involving financial and/or non-financial media and devices, where apparatus has an authenticator that authenticates an identity of a user [Fig.1-2, and paragraph 0019 – 0020].

Therefore, It would have been obvious to one ordinary skilled in the art at the time of invention to combine the teachings of Abbot and Burger, because Burger's system of portable electronic authorization with plurality of unique devices for providing plurality of services after authenticating the device and user by using embedded ID would enhance the trustworthiness of the user of portable device when tracking the device in a external network (co.7 line 9 to line 15).

3. Claims 2-3, 10, 12-114, and 21-23 are rejected applied as above rejecting Claims 1, and 11. Furthermore, the system of Abbott and Burger teaches and describes a system and method wherein

As per Claim 2, the serial bus port comprises any one of a firewire port, USB port or an infiniband port (Abbot: col.3 line 26 to line 30, col.5 line 12 to line 14, Fig.1, Item 130, Fig.4 Item 402))

As per Claim 3, the storage medium comprises a memory (Abbot: Fig. 2A, col.4 line 50 to line 62).

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As per Claim 10, the security information can be enhanced or modified by downloading data to the device (Abbot: col.8 line 20 to line 33, and col.10 line 6 to line 11).

As per Claim 12, the serial bus port comprises any one of a firewire port, USB port or an infiniband port (Abbot: col.3 line 26 to line 30, col.5 line 12 to line 14, Fig.1, Item 130, Fig.4 Item 402).

As per Claim 13, each of the least one touchpoints comprises a personal computer (Abbot: Fig.1 Item 102).

As per Claim 14, the storage medium comprises a memory (Abbot: Fig. 2A, col.4 line 50 to line 62).

As per Claim 21, the security information within a device can be enhanced or modified by downloading data to the device (Abbot: col.8 line 20 to line 33, and col.10 line 6 to line 11).

As per Claim 22-23, the key touchpoints comprises any one of airports, car rentals, or banks (Burger: [0125, 0135, and 0152]).

4. Claims 7-9, 10, and 18-20 are rejected applied as above rejecting Claims 4, and 15.

Furthermore, the system of Abbott and Burger teaches and describe a system and method wherein:

As per Claim 7, the identity of the individual being provided access is provided via a password (Abbot: col.3 line 26 to line 39).

As per Claim 8, the identity of the individual is provided via biometric information (Abbot: col.3 line 45 to line 52).

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As per Claim 9, the security information to be stored on the medium is tamper proof (Abbot: col.5 line 47 to line 50).

As per Claim 18, the identity of the individual is provided access via a password (Abbot: col.3 line 26 to line 39).

As per Claim 19, the identity of the individual is provided via biometric information (Abbot: col.3 line 45 to line 52).

As per Claim 20, the plurality of levels are tamper proof (Abbot: col.5 line 47 to line 50).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SZ

October 18, 2006

[Signature]
STED 2/18
REMOVED EXAMINER
AM 11/27